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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/532,670

06/16/2005

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441P091

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04/23/2008

EXAMINER

AULAKH, CHARANJIT

ART UNIT

PAPER NUMBER

1625

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/532,670	<b>Applicant(s)</b> KITAGAWA ET AL.	
	<b>Examiner</b> Charanjit S. Aulakh	<b>Art Unit</b> 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/5/05, 2/8/07, 6/27/07</u> .                                 | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Applicant's election of group I in paper filed on 4/3/08 is acknowledged. Because applicants did not specifically and distinctly point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse; see MPEP 818.03(a).

2. Claims 1-11 are pending in the application.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The following eight different factors (see Ex parte Foreman, 230 USPQ at 547; Wands, In re, 858.F. 2d 731, 8 USPQ 2d 1400, Fed. Cir. 1988) must be considered in order for the specification to be enabling for what is being claimed:

Quantity of experimentation necessary, the amount of direction or guidance provided, presence or absence of working examples, the nature of the invention, the state of the prior art, the relative skill of those in the art, the predictability or unpredictability and the breadth of claims. In the instant case, the specification is not enabling based on at least four of the above mentioned eight different factors such as quantity of experimentation

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necessary, the amount of direction or guidance provided, presence of working examples, state of the prior art, unpredictability and the breadth of claims.

In regard to lack of enablement issue of instant claims 1-11 for derivatives ( hydrates, solvates or prodrug forms ) of instant compounds of formula (I), there is no teaching or guidance present in the specification for preparing any specific hydrates ( mono, di, tri or tetra ), solvates or prodrugs. Preparation of specific hydrates or solvates of any compound is a very specialized field and involves their characterization using different techniques such as infrared spectrum, XRD powder diffraction etc. There is no teaching or guidance present in the specification regarding any specific solvents used for preparing specific hydrates or solvates and their characterization using any techniques such as XRD powder diffraction or infrared spectrum etc. There is not even a single example present for preparing any specific hydrate or solvate of instant compounds of formula (I). There is lot of unpredictability regarding stability of different hydrates or solvates of any compound in the art. The instant compounds of formula (I) encompasses hundreds of thousands of compounds based on the values of variables R1-R4, t, d, e, f, P and A and therefore, in absence of such teachings, guidance, presence of working examples and unpredictability, it would require undue experimentation to select specific hydrates or solvates of instant compounds with enhanced stability properties.

In regard to prodrug forms, there is no teaching or guidance present in the specification for preparing specific types of prodrug form such carboxylic acid esters, amino acid or amide esters, phosphate esters, phosphono esters , sulfate esters etc. There is not

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even a single working example present in the specification for preparing any type of specific prodrug form of instant compounds of formula (I). There is lot of unpredictability in the art for efficacy of different types of prodrug forms of any known compound following their in vivo administration since their efficacy depends upon various factors such as absorption from gut, metabolism by esterases etc. The instant compounds of formula (I) encompasses hundreds of thousands of compounds based on the values of variables R1-R4, t, d, e, f, P and A and therefore, in absence of such teachings, guidance, presence of working examples and unpredictability, it would require undue experimentation to select specific types of prodrug forms of instant compounds of formula (I) which will be effective following in vivo administration.

In regard to enablement rejection of claim 11, the specification teaches inhibitory effect of instant compounds in mouse colon tumor ( see table 1 on page 24 ). Based on these teachings, the instant compounds will have utility in treating colon cancer only. There is no teaching or guidance present in the specification or prior art that structurally closely related compounds are well known to have therapeutic utility for treating every known cancer in the art. There are no working examples present showing efficacy of instant compounds in known animal models or known cell lines of every known cancer in the art. The instant compounds of formula (I) encompasses hundreds of thousands of compounds based on the values of variables R1-R4, t, d, e, f, P and A and therefore, in absence of such teachings, guidance, presence of working examples and prior art, it would require undue experimentation to demonstrate efficacy of instant compounds in

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known animal models or known cell lines of every known cancer and hence their utility for treating every known cancer.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 5, 6 and 9-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In independent claim 5, the value of variable A defined as ----a bonding group---- is indefinite since specific values are not defined.

In independent claim 5 as well as claim 6, the values of variables R1, R2, R3 and R4 defined as ---- optionally having a substituent ----- are indefinite since specific substituents are not defined.

7. Claims 1-4 and 9-11 are objected for containing non-elected subject matter.

***Allowable Subject Matter***

8. The following is a statement of reasons for the indication of allowable subject matter:

The instant compounds directed to the elected group are allowable over the prior art since they are neither disclosed nor obvious over the prior art. In the prior art, Tsujihara ( EP 0 757 049 A1, cited on applicant's form 1449 ) discloses camptothecin derivatives which are closely related to the instant compounds. However, the compounds of Tsujihara ( see examples 54-69 in table 1 on page 35 ) differ in structure by having different value of variable R and furthermore, there is no teaching, suggestion or

motivation in the prior art to modify the compounds of Tsujihara to prepare the instant compounds.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charanjit S. Aulakh whose telephone number is (571)272-0678. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on (571)272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charanjit S. Aulakh/  
Primary Examiner, Art Unit 1625